

Application Serial No. 10/076,335

Amendment C - Reply to Non-Final Office Action of January 12, 2006

**REMARKS/ARGUMENTS**

This paper is being submitted in response to the Non-Final Office Action dated January 12, 2006, having a shortened statutory period set to expire on April 12, 2006, wherein:

Claims 1-5, 7-9, 11, 12, 21, and 23-27 were pending; and

Claims 1-5, 7-9, 11, 12, 21, and 23-27 were rejected.

Claims 1, 9, and 24 have been amended, no claims have been canceled, and new claims 29 and 30 have been added by this amendment. Accordingly, claims 1-5, 7-9, 11, 12, 21, and 23-27 are currently pending in the present application. Applicants submit that no new matter has been added by this amendment and respectfully request reconsideration of all pending claims in light of the amendments and remarks made herein.

**Formal Matters**

In the present Office Action, the Examiner has withdrawn the indicated allowability of Applicants' previously-pending claims 22 and 28. Subject matter of the indicated claims was incorporated into Applicants' claims 1, 9, and 24 in Amendment B, submitted on December 5, 2005. In light of the Examiner's withdrawal of his indication of allowability, Applicants have amended claims 1, 9, and 24 to excise the described subject matter and submitted new claims 29 and 30 separately directed to same.

**Claim Rejections under 35 U.S.C. §103**

In the present Office Action, claims 1, 3, 7-9, 11, 24, and 26 were rejected as being unpatentable over United States Patent No. 5,638,423 issued to Grube, et al., (hereinafter, "*Grube*") in view of United States Patent No. 6,756,917 issued to Gould, et al., (hereinafter, "*Gould*") and claims 2, 4, 5, 12, 21, 23, 25, and 27 were rejected as being unpatentable over *Grube* in view of United States Patent No. 6,300,863 issued to Cotichini, et al., (hereinafter, "*Cotichini*"). While not conceding that any the Examiner's cited references qualify as prior art but in the interest of expediting prosecution, Applicants have elected to traverse the Examiner's rejections as follows. Applicants reserve the right, for example in a continuation application, to

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establish that one or more of the Examiner's cited references do not qualify as prior art with respect to invention embodiments claimed in the above-identified application.

With regard to Applicants' claim 1, the Examiner states that *Grube* discloses a method for determining a method for determining [a position of] an electronic device within a wide area network comprising,

*monitoring traffic on the wide area network utilizing the tracing tool wherein the monitoring comprises intercepting of the communication between the electronic device and the second network element including the identifying indicia in response to the physical separation (proximity message being set when a response is not received from proximity card and sent to central controller, see col. 3, lines 26-48)*

Applicants respectfully disagree.

*Grube fails to teach, show, or suggest "intercepting data" as claimed*

As currently amended, Applicants' claim 1 (emphasis supplied) recites a method for determining a position of an electronic device within a wide area network, comprising *inter alia*,

*intercepting data of said communication between said electronic device and said second network element including said identifying indicia in response to detecting said physical separation*

*Grube* teaches a method of detecting use of a stolen communication unit. According to *Grube*'s teaching, a communication unit 102 (e.g., a portable radio) communicates with a communication resource allocator or central controller 101 via a first communication path 103 and with a proximity user card 115 via a second communication path 119. *Grube* teaches that,

*the communication unit transmits user identification information, or signal, over a second RF communication path to a proximity user card. If the proximity user card has received the user identification signal, the proximity user card prepares a response as described above....If the proximity user card has transmitted a response, the communication unit checks to determine whether it has received the response (202). If the response is received and verified, the communication unit clears any indication of an proximity message (203). If, however, the response was not received, or the response was inappropriate, the communication unit sets the proximity message (204). Regardless of whether the proximity message is set or not, the proximity message is transmitted over a first RF communication path to the central controller (205). The proximity message may be as simple as a single bit included in an inbound signaling word or as complex as transmitting an encoded version of the response from the proximity user card (115). As should be apparent to one skilled in the art, the proximity message may be varied to meet the requirements of the system. (*Grube*, Column 3, Lines 10-36, emphasis supplied)*

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*Grube* further teaches that the described communication only occurs between the proximity card and the communication unit within approximately 20 feet such then when the proximity card and communication unit are separated, the proximity card will fail to transmit a response. Consequently, once separated according to *Grube*'s teaching, the proximity card and communication unit have no communication to intercept.

The Examiner's indication that "monitoring" and "intercepting" as claimed are taught by the setting of a proximity message when a response is not received from proximity card and sent to central controller implies that the "electronic device" and "second network element" of Applicants' claim are taught by *Grube*'s proximity card and communication unit. However, since the "intercepting" of Applicants' claim is performed in response to detecting "a physical separation of said electronic device and an associated user" Applicants respectfully submit that the Examiner's proposed application of *Grube*'s teaching to Applicants' claims is in error.

Applicants therefore respectfully submit that none of the cited portions of *Grube* teach, show, or suggest the indicated limitations of Applicants' claim. No portion of *Gould* or *Cotichini* is cited by the Examiner as teaching, showing, or suggesting "intercepting" as claimed. Consequently Applicants submit that a *prima facie* case of obviousness has not been established with respect to Applicants' claim 1 as amended.

Claims 9 and 24 each include one or more limitations substantially similar to those described with respect to claim 1 and are therefore allowable for the same reasons as those stated for claim 1. All remaining depend directly or indirectly from claim 1, 9, or 24 are each therefore similarly allowable. Consequently, Applicants respectfully submit that all claims, as amended herein, are allowable in view of the Examiner's references of record.

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**CONCLUSION**

In light of the amendments and remarks made herein, Applicants submit that all pending claims are allowable and earnestly solicits notice thereof.

No extension of time for this amendment is believed to be necessary. However, in the event an extension of time is required, that extension of time is hereby requested. Please charge any fee associated with an extension of time as well as any other fee necessary to further the prosecution of this application and credit any overpayment to **IBM CORPORATION DEPOSIT ACCOUNT No. 09-0447.**

Respectfully submitted,



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